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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,824	07/11/2005	Francesco Carlo Tinti	26789U	4265
20529	7590	06/15/2007		
NATH & ASSOCIATES 112 South West Street Alexandria, VA 22314			EXAMINER PHAN, HAU VAN	
			ART UNIT 3618	PAPER NUMBER
			MAIL DATE 06/15/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/541,824	Applicant(s) TINTI, FRANCESCO CARLO	
	Examiner Hau V. Phan	Art Unit 3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

~ Acknowledgment

1. The amendment filed on 5/12/2007 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-8, the phrase "Engine compartment partitioning layer" renders the claim indefinite because it is unclear whether the claims recite many engine compartment partitioning layer or one.

Regarding claims 1-15, it is not clear, whether the application claimed an engine compartment partitioning layer or a combination of the engine compartment partitioning layer and a vehicle engine compartment.

Regarding claim 1-2 and 7-8, the phrase "Partitioning layer according to claim 2, wherein said partitioning layer" is not clear, whether it is the same one or not.

Regarding claim 9, the phrase "an engine compartment" is not clear, whether it is the same with an engine compartment in claim 1.

Regarding claims 9-11, the preamble recites a method of using an engine compartment partitioning layer comprising using and forming. It is not clear the applicant intend to have the step of or comprising some thing.

Regarding claims 9-10, the phrase "using within an engine compartment a partitioning layer" is not clear, whether positioning the engine compartment partitioning layer within an engine compartment to partition the engine compartment from some thing or what.

Regarding claims 10-11, the claims recite a method of using several layers comprising forming. It is unclear the several layers had been mounted to the engine compartment or just any partitioning layer not belong to the vehicle. The phrase "comprising forming" is not clear.

4. Claims 9-11 provides for the use of a method of using, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 9-11 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Murakawa et al. (5,113,819).**

Murakawa et al. in figures 1-4, disclose an engine compartment-partitioning layer for use in an engine compartment. The partitioning layer partitions the engine compartment and forms at least one acoustically effective cavity within the closed engine compartment (see figure 2).

Regarding claim 2, Murakawa et al. disclose the partitioning layer consisting of a carrier layer (34) and a sound absorbent layer (35).

Regarding claim 3, Murakawa et al. disclose carrier layer comprising a compressed phenolic resinous nonwoven layer.

Regarding claim 4, Murakawa et al. disclose the carrier layer that is provided with a first water and oil repellent layer, which is made of a textile scrim or felt layer, on the engine hood side.

Regarding claim 5, Murakawa et al. disclose the sound absorbent layer comprising a slightly compressed phenolic resinous layer, which is made of a textile scrim or felt layer.

Regarding claim 6, Murakawa et al. disclose the sound absorbent layer providing with a second water and oil repellent layer, which is made of a textile scrim or felt layer, toward the engine compartment floor or the ground.

Regarding claim 7, Murakawa et al. disclose the partitioning layer that is made of several joinable and mutually complementary sections.

Regarding claim 8, Murakawa et al. disclose the partitioning layer providing with at least one acoustically effective aperture.

Regarding claim 9, Murakawa et al. disclose the partitioning layer that is used within the engine compartment.

Regarding claim 10, Murakawa et al. disclose the partitioning layer that is used within the engine compartment for forming a plurality of acoustically effective cavities within the engine compartment.

Regarding claim 11, Murakawa et al. disclose the cavities having differing volumes.

Response to Arguments

Applicant's arguments filed 5/12/2007 have been fully considered but they are not persuasive. In response to applicant's remark that the Examiner has not provided enough evidence in support of the rejection of the presently claimed invention and instead seems to be asserting Official Notice of the disclosure, teaching or suggestion of the presently claimed invention in the cited prior art. If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific

factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. The examiner disagrees, because Murakawa et al. in figure 2, disclose an engine partitioning layer (34) having a sound absorbing layer (35), which is partitioned an engine compartment and controlling sound or absorbing sound from the engine (col. 3, lines 1-2).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hau V. Phan whose telephone number is 571-272-6696. The examiner can normally be reached on 7:30AM-4:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on 571-272-6914. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hau V Phan
Primary Examiner
Art Unit 3618

Hau Phan
6/7/07